



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,179	09/04/2001	Kazuo Kuroda	Q66100	9852

7590 01/03/2006

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

JUNG, DAVID YIUK

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,179

Applicant(s)

KURODA ET AL.

Examiner

David Y. Jung

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 9/26/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/2005.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

CLAIMS PRESENTED

Claims 1-16 are presented.

Response to Arguments

The previous examiner rejected all claims under 35 USC 102.

Applicant argued that the priority date of the 5C reference must be questioned because of the mention of PDI1394L41 A/V link. Applicant argued that this A/V link was not released until the 4th quarter of the year 2000. This is not persuasive because the 5C reference was a white paper; such white papers, by their very nature, often discuss technologies before their release – that is one of the purposes of a white paper.

Applicant also argued (at page 19 of the amendment) that the two transfer modes of the reference is not explicit about their being used for asynchronous or synchronous modes. This is somewhat persuasive. If such modes are not explicitly stated, then the rejection should not have been made under 35 USC 102.

Nevertheless, it was well known to those of the ordinary skill in the art to use both asynchronous and synchronous transfers for the motivation of getting the benefits of both types of transfers without being limited to the benefits of only one type of transfer. Therefore, the rejections should have been under 35 USC 103.

In conclusion, applicant's arguments, with respect to the previous examiner's rejections of claims under 35 USC 102, have been fully considered and are persuasive

Art Unit: 2134

as to the non-novelty but not as to non-obviousness. Therefore, new rejections are made under 35 USC 103.

CLAIM REJECTIONS

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5C reference (as cited in the previous Office Action.)

Regarding claim 1, the 5C reference teaches as noted in the previous Office Action.

These passages of the 5C reference do not teach being used for "synchronous" or "synchronous" modes in the sense of the claim.

Nevertheless, it was well known to those of the ordinary skill in the art to use both asynchronous and synchronous transfers for the motivation of getting the benefits of both types of transfers without being limited to the benefits of only one type of transfer.

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify 5C reference for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Regarding claims 2-14, the 5C reference teaches these features as noted in the previous Office Action.

Regarding claims 15-16, these claims (as noted at page 20 of the applicant's own amendment) are analogous to the other claims. For the reasons noted in the rejections of the other claims, these claims are not patentable.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:


(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Greg Morse whose telephone number is (571) 272-3838.

David Jung

Patent Examiner

12/23/05

A handwritten signature in black ink, consisting of a large loop followed by several sharp, angular strokes and a long horizontal tail.